

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	O'Donnell et al.)	Examiner:
)	Richard G. Hutson
Serial No.	:	10/673,098)	
)	Art Unit:
Cnfrm. No.	:	2627)	1652
)	
Filed	:	September 26, 2003)	
)	
For	:	THERMOTOGA MARITIMA DELTA)	
		PRIME POLYMERASE SUBUNIT AND)	
		USE THEREOF)	

DECLARATION OF ADAM FORMAN

I, ADAM FORMAN, hereby declare:

1. I am a licensed patent attorney, Registration No. 51,690, and am currently employed by the Rockefeller University with the Office of Technology Transfer. I have held that position since May 29, 2007.

2. In my position at the Office of Technology Transfer, I am responsible for the management of the Rockefeller University patent portfolio, which includes: managing a limited budget; evaluation of new technology disclosures; prior art searches; drafting and filing of in-house patent applications; the review and analysis of office actions; management of outside counsel; Bayh-Dole Act compliance; the review and negotiation of complex agreements; license compliance; and managing two entry level, clerical employees. The Rockefeller University patent portfolio consists of over a hundred pending applications in the United States and in foreign jurisdictions and as many, if not more, issued patents in the United States and foreign jurisdictions. A percentage of these cases are licensed and financially supported by the licensees.

3. Rockefeller University's Office of Technology Transfer had a number of extraordinary unfortunate events occur in 2009. In particular, many of our licenses were

terminated, and decisions had to be made concerning what cases would be kept pending with the University's limited budget. It is my understanding that Rockefeller University had never had so many licenses terminated within such a short time frame. In order to operate within our patent budget, I had to review many complex patent families in addition to my regular responsibilities and make the best decision I could to retain the value of the patent family with a very limited budget and tight deadlines, to meet our mission of transferring technology to the commercial sector for the "public good."

4. The Rockefeller University patent family for RU 339, RU 371, RU 429 and RU 458 is one of the complex patent families in which a license was terminated. The cases were all financially supported by the licensee and the patent family preceded my employment start date. The patent family comprised a series of filings that encompassed many bacterial species of *Pol C*, their multiple subunits, and numerous sequence listings. In 2008, the patent family that was licensed comprised seventeen pending U.S. applications, and three issued patents. The following are the applications that were pending in the United States in 2008:

Rockefeller Ref. No.	Country	Serial No.	Organism	Subunit
RU-339	United States	09/642,218	<i>T. thermophilus</i>	τ and γ (nucl. acid)
RU-339	United States	10/673,120	<i>A. aeolicus</i>	δ' (amino acid)
RU-339	United States	10/671,134	<i>A. aeolicus</i>	δ' (nucl. acid)
RU-339	United States	10/673,098	<i>T. maritima</i>	δ' (amino acid)
RU-339	United States	10/671,419	<i>T. maritima</i>	δ' (nucl. acid)
RU-339	United States	10/671,859	<i>B. stearothermophilus</i>	δ (and δ' and τ) (amino acid)
RU-339	United States	10/670,844	<i>B. stearothermophilus</i>	τ (nucl. acid)
RU-339	United States	10/671,403	<i>B. stearothermophilus</i>	δ (nucl. acid)
RU-339	United States	10/671,106	<i>B. stearothermophilus</i>	δ' (nucl. acid)
RU-339	United States	10/672,638	<i>B. stearothermophilus</i>	<i>PolC</i> (amino acid)
RU-339	United States	10/671,412	<i>B. stearothermophilus</i>	<i>PolC</i> (nucl. acid)
RU-339	United States	10/673,127	<i>B. stearothermophilus</i>	β (amino acid)
RU-339	United States	10/671,207	<i>B. stearothermophilus</i>	β (nucl. acid)
RU-339	United States	10/673,119	<i>B. stearothermophilus</i>	SSB (amino acid)
RU-339	United States	10/670,817	<i>B. stearothermophilus</i>	SSB (nucl. acid)
RU-371	United States	10/282,287	<i>S. aureus</i>	τ and γ (amino acid)

RU-429	United States	12/146,353	<i>S. pyogenes</i>	β (amino acid)
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5. In order to maintain the patent family based on the University's limited patent budget, I decided to keep one application pending within each family. It was my intent to select applications which disclosed all subject matter found in the applications for that family and continue with examination of selected applications. This was a significant departure from the previous patent strategy requested and financially supported by the licensee for RU-339, RU-371, RU-429 and RU-458, where multiple applications were being simultaneously prosecuted.


6. Based upon a report generated by the in-house database that listed all the pending cases and filing dates, I chose to file a continuation application based on U.S. Patent Application Serial No. 09/642,218, because I believed the application would require the least amount of work by outside counsel, it would contain all of the subject matter in all seventeen pending cases, and it had the latest response date in the family. This continuation application was assigned U.S. Patent Application Serial No. 12/478,741.

7. However, as I was reviewing the Notice to File Missing Parts for U.S. Patent Application Serial No. 12/478,741 to determine which claims to pursue, it came to my attention that several sequences, including SEQ ID NO: 148, were not listed in this application. Accordingly, I determined at this time that I unintentionally provided the wrong instructions to outside counsel stating "do not file a response" to the December 5, 2008, office action for U.S. Patent Application Serial No. 10/673,098, which includes SEQ ID NO: 148. I had intended to keep a patent application with this subject matter pending and erroneously believed that such subject matter was present in U.S. Patent Application Serial No. 12/478,741. The entire delay in filing the enclosed response to the December 5, 2008, office action from the due date of this office action (March 5, 2008) until the filing of this petition was unintentional.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so

made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

October 6, 2009
Date



Adam Forman
Registration No. 51,690